

## DETAILED ACTION

### Election Requirement

1. Applicant's election of sodium lauryl ether sulphate for Species I, Laureth-4 for Species II, and iso-pentane for Species III in the reply filed on 10/31/2007 are acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### Claims

2. Claims 1-35 are under consideration in this action.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 6-13, 17-19, 21-23, 25-28, and 30-35 are rejected under 35 U.S.C. 102(b) as anticipated by US Patent No. 4,772,427 to Dawson et al.

4. Dawson et al. discloses a post-foaming cleansing composition (abstract) comprising an anionic surfactant (abstract), a non-ionic gelling agent (col. 4, lines 49-65) [It is noted by examiner that polyoxyethylene (4) lauryl alcohol and Brij 30 are

synonyms for Laureth-4 and that Laureth-4, as described by Applicant, is a non-ionic gelling agent], a post foaming agent, such as isopentane (col. 5, line 26), with a ratio of the anionic surfactant and the non-ionic gelling agent being 4:1 or greater (abstract), and the viscous gel being formed at least 4 minutes after the addition of the post-foaming agent (col. 8, line 53 to col. 9, line 2). In regards to the limitation of the composition remaining stable for at least 12 months when stored at 20°C to 25°C, Dawson et al. discloses that the composition is stable at (col. 3, lines 24-26). Dawson et al. discloses that the compositions are mixed and stored at specific conditions before they are dispensed into suitable containers able to withstand pressure (col. 8, line 41 to col. 9, line 19). The compositions are disclosed as a shower gel. It is expected that the compositions disclosed in Dawson et al., packaged and stored in such a manner, would remain stable for at least 12 months. One of ordinary skill in the art would expect that a product for consumer distribution, wherein only a portion of the product is used per day such as a shower gel, would remain stable for at least 12 months.

5. It would also be expected that compositions comprising of the same components in the same amounts would remain stable for the same amount of time when stored under the same conditions. The Office does not have the facilities capable of testing the length of time that the compositions disclosed by Dawson et al. will remain stable, therefore the burden has been shifted away from the office and it is now incumbent upon Applicant to show that the compositions disclosed in Dawson et al. would not remain stable

6. Dawson et al. also discloses the non-ionic gelling agent as being Laureth-4 (col. 4, lines 49-65), the non-ionic gelling agent present from between 0.01% and 8% (col. 10, examples 9 and 10), the total amount of surfactant present as between 0.01% and 30% of the total composition (col. 10, examples 3 and 4), the composition comprising a saturated aliphatic hydrocarbon having from 4 to 6 carbons (col. 5, lines 22-26), the post foaming agent comprising of 0.01% to about 14% of the total composition (col. 10, lines 55-57 and col. 9 example 1), a method for manufacture of the claimed composition (col. 8, line 53 to col. 9, line 2). In regards to the limitation of the composition remaining stable for at least 12 months when stored at 20°C to 25°C, Dawson et al. discloses that the composition is stable at (col. 3, lines 24-26). In regards to the limitation of the gel rigidity remaining unchanged for at least 10 minutes after the post-foaming agent is added, the same argument as paragraph 5 applies and it is incumbent upon Applicant to show that the compositions of Dawson et al. do not retain these properties .

7. Dawson et al. also discloses the anionic surfactant comprises alkali metal alkyl ether sulfates and sodium lauryl ether sulphate (col. 10, examples 3 and 4) [It is noted by examiner that sodium lauryl ether sulphate is an alkali metal alkyl ether sulfates], and the composition comprising iso-pentane (col. 5, lines 22-26).

8. Claims 1-4, 6-13, 17-19, 21-23, 25-28, and 30-35 are rejected under 35 U.S.C. 102(b) as anticipated by PCT Application Publication WO 97/03646 of International Application No. PCT/GB96/01744 to Hall et al.

Hall et al. discloses a post-foaming cleansing composition (abstract and page 1, lines 1-3) comprising an anionic surfactant (page 5, line 20 to page 6, line 1) [It is noted by examiner that glycol esters are anionic surfactants, as described by Applicant in claim 2 of the instant application], comprising a post-foaming agent (abstract), wherein the ratio of anionic surfactant to non-ionic gelling agent is 4:1 or greater (page 14, table 3 and page 15, table 4). 71.5% anionic surfactant and 5% non-ionic gelling agent is a ratio of greater than 4:1. Hall et al. does not disclose that a viscous gel structure is formed at least 4 minutes after the post-foaming agent is added or that the composition is stable for at least 12 months when stored at 20°C to 25°C but the same argument as paragraph 5 applies and it is incumbent upon Applicant to show that the compositions of Dawson et al. do not retain these properties.

9. Hall et al. also discloses that the composition comprises glycol esters as the ionic gelling agent (page 5, line 20 to page 6, line 1), an anionic surfactant with an amphoteric surfactant (page 7, lines 8-10) [It is noted by the examiner that detergents are surfactants]. Hall et al. also discloses that the total amount of surfactant is about 0.01% to 30% of the total composition (page 8, example 1), the post-foaming agent comprising a saturated aliphatic hydrocarbon having from 4 to 6 carbons, and specifically being isopentane (page 7, lines 4-6) and the post-foaming agent constitutes from about 0.01% to 14% (page 8, line 26). Hall et al. discloses a method for manufacture of the claimed composition (page 8, lines 11-29). Although Hall et al. does not specifically disclose the limitations of the composition remaining stable for at least 12 months when stored at 20°C to 25°C and the limitation of the gel rigidity remaining

unchanged for at least 10 minutes after the post-foaming agent is added, the same argument as paragraph 5 applies and it is incumbent upon Applicant to show that the compositions of Dawson et al. do not retain these properties. Hall et al. also discloses the composition comprising alkali metal alkyl ether sulfates and sodium lauryl ether sulphate (page 8, example 1) [It is noted by examiner that sodium lauryl ether sulphate is an alkali metal alkyl ether sulfates].

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.
3. Ascertaining the differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall et al. in view of Dawson et al. For the reasoning of rejection for claims 1-2, 5-10, 14, 17, 20-21, 24-26, and 29-35 see the arguments found above in the 102 rejections to Dawson et al. For the reasoning of rejection for claims 3-4, 11-13, 15-16, 18-19, 22-23, and 27-28 see below.

#### *Applicant Claims*

Applicant claims a post-foaming composition comprising an anionic surfactant, a non-ionic gelling agent, a post-foaming agent, optionally an amphoteric surfactant, wherein the components are claimed to be different specific compounds found at different percentages within the composition.

#### ***Determination of the Scope and Content of the Prior Art (MPEP §2141.01)***

Hall et al. discloses:

- 1) A post foaming cleansing composition (abstract and page 1, line 1)
- 2) An anionic surfactant, comprising sodium lauryl ether sulphate at an amount of 0.01% to 30% (abstract and page 8, example 1).

- 3) A non-ionic gelling agent, comprising glycol esters (page 5, line20 to page 6, line1)
- 4) A post-foaming agent at an amount of 0.01% to 14%, said agent comprising isopentane (page 7, lines 4-6 and page 8, line 27)
- 5) The ratio of anionic surfactant to non-ionic gelling agent at 4:1 or greater (page 14, table 3 and page 15, table 4). 71.5% anionic surfactant and 5% non-ionic gelling agent is a ratio of greater than 4:1.
- 6) The composition comprising an anionic surfactant and an amphoteric surfactant (page 7, line 8-10).
- 7) A method for manufacturing said composition (page 8, line 11-29).

*Ascertainment of the Difference Between Scope the Prior Art and the Claims*  
**(MPEP §2141.012)**

Hall et al. does not teach:

- 1) The non-ionic gelling agent consisting of Laureth-4
- 2) The non-ionic gelling agent comprising of 0.01% to 8% of the total composition

These deficiencies are cured by Dawson et al.

***Finding of Prima Facie Obviousness Rational and Motivation***  
**(MPEP §2142-2143)**

Although Hall et al. does not specifically teach laureth-4, the reference does teach the use of thickeners, also known as gelling agents. Glycol esters are one specific example of thickener/gelling agent that is taught in the instant application as well as Hall et al. Dawson et al. does teach the use of laureth-4 as a thickener/gelling agent. Dawson et al. and Hall et al. are both in the same field of endeavor, which is to provide a stable post-foaming gelling cleanser.

Hall et al. also does not teach laureth-4 with a specific percentage range. Hall et al. does teach that the amount of thickener/gelling agent used depends on the particular thickener/gelling agent employed and the reference also teaches a specific percentage range for one thickener/gelling agent embodiment. Dawson et al. not only teaches laureth-4 as the specific thickener/gelling agent but the reference also teaches 1% and 7% of the total composition constitutes laureth-4, which anticipates the instant claim of from about 0.01% to about 8% of a non-ionic gelling agent. As stated above Hall et al. and Dawson et al. are in the same field of endeavor. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Dawson et al. with those of Hall et al. to modify the thickener/gelling agent in the composition of Hall et al. and to use the specific amounts of thickener/gelling agent that are disclosed by Dawson et al.

### **Double Patenting**

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

12. The following claims are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the below listed claims of copending Application No. 10/824,202.

13. Although the conflicting claims are not identical, there is only one additional limitation listed, which is that of a gel which retains its structure for at least 12 months.

14. This limitation does not render the claims patentably distinct from each other because it is expected that the compositions disclosed in 10/824,202 packaged and stored in the disclosed manner, would remain stable for at least 12 months. One of ordinary skill in the art would expect that a product for consumer distribution, wherein

only a portion of the product is used per day such as a shower gel, would remain stable for at least 12 months. It would also be expected that compositions comprising of the same components in the same amounts would remain stable for the same amount of time when stored under the same conditions. The Office does not have the facilities capable of testing the length of time that the compositions disclosed by 10/824,202. will remain stable, therefore the burden has been shifted away from the office and it is now incumbent upon Applicant to show that the compositions disclosed in 10/824,202 would not remain stable.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-9 are provisionally rejected in view of Claims 1-9 of application 10/824,202 respectively.

Claims 11-35 are provisionally rejected in view of Claims 10-34 of application 10/824,202 respectively.

**Inquiries**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUKE E. KARPINSKI whose telephone number is (571)270-3501. The examiner can normally be reached on Monday-Thursday 9-4 est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisors, Ardin H. Marschel or Cecilia Tsang can be reached on 571-272-0718 or 571-272-0562 respectively. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LEK

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